

The requirement for provisional election of a single species for initial examination is common and proper, but in this case the Examiner misunderstood the meaning and purposes of "provisional election of a single species". The election is **provisional**, because it will not have any final effect unless the elected species is unpatentable ("The provisional election will be given effect in the event that the Markush-type claim should be found not allowable." See MPEP Section 803.02). It is not a license for the Examiner to further arbitrarily divide the elected subject matter, Group I, into numerous subgroups.

In the instant case, upon finding the elected species of the elected subject matter (Group I) patentable, rather than continuing examination with other species of the claims as required by the PTO's own guideline (see MPEP Section 803.02.), the Examiner erroneously objected to the generic claim for containing non-elected subject matter.

The only justification advanced by the Examiner for imposing this unusual restriction/objection is that the species of the generic claim fell into different classifications and are "patentable distinct." While Applicants do not necessarily disagree on that point, Applicants however respectfully submit that "patentable distinct" is not a sufficient condition for imposing restrictions on the Markush type of claims. Treating "patentable distinct" as a sufficient condition, as the Examiner did in this case, would contradict with the PTO's own guideline: MPEP Section 803.02.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The

provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. (emphasis added)

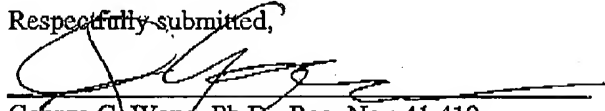
Therefore, although the Markush claims (particularly, claim 1) of the present application contain a number of patentably distinct species and the Examiner may require a provisional election of a single species prior to examination on the merits, Applicants respectfully submit that there is no legal requirement for them to be each individually prosecuted in separate applications. The compounds claimed in the present invention all share a common utility (i.e., upregulating eNOS-expression, pages 142-148) and share a substantial structural feature (i.e., Formula I defined in claim 1) which is essential to the their ability of upregulating eNOS-expression. Clearly, the Markush claims of the instant application meet the "unity" requirement and should be prosecuted in one application.

Based on the Examiner's rationale that each "patentably distinct" species within the scope of a generic claim must be prosecuted in a separate application (see pages 3 and 4, Office Action of February 25, 2004), one would easily divide any application with a chemical genus claim into hundreds, if not thousands, of applications---clearly an unreasonable result. It is respectfully submitted that a rationale which leads to such an unreasonable conclusion, cannot be correct.

In view of the foregoing arguments, reconsideration and withdraw of the objection of claims 1-6, 21 and 22, which is based on an improper and inexplicit restriction requirement, is earnestly solicited.

Enclosed herewith is a Petition under 37 C.F.R. § 1.136(a) to extend the time for response for one month, or until June 25, 2004. It is believed that no additional fees and charges are required at this time in connection with the application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No.18-1982.

Respectfully submitted,



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